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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,455	03/25/2004	Darko Pervan	033462-045	4858

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EXAMINER	
GILBERT, WILLIAM V	

ART UNIT	PAPER NUMBER
3635	

NOTIFICATION DATE	DELIVERY MODE
11/15/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/808,455	PERVAN, DARKO	
	Examiner	Art Unit	
	William V. Gilbert	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,3-12 and 17* is/are allowed.

6)☒ Claim(s) *13-16,18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *21 August 2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a non-final action. Claim 2 is cancelled. Claims 1 and 3-18 are pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-15, 17 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6—9 and 11-14 and 17-20 of

copending Application No. 10/975923. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are substantially similar as follows:

	10/808455	10/975923
Claim	1	6
	3	7
	4	8
	5	8
	6	9
	7	11
	8	12
	9	13
	10	11
	11	12
	12	13
	13	14
	14	18
	15	17
	17	19
	18	20

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 16 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/975923. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the prior art of record does not disclose the floorboards laid in parallel rows, it would be obvious to a person having ordinary skill in the art at the time the invention was made because it is well known in the art to place floorboards on the ground in parallel rows.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terbrack (U.S. Patent No. 4,426,820).

Claim 13: Terbrack discloses a method for making a floor where the long sides (Figs. 12 and 13) have pairs of opposing connectors (41, 40') for locking adjoining floorboards both vertically and horizontally and the short sides have opposing connectors (41, 40') where the connectors of the floorboards on the long sides allow locking together by an angular motion along the upper joint edge (40'), and the short side connectors allow locking together by an essentially vertical motion; the

floorboards comprise a first and second type of floorboard arranged in a mirror-inverted manner (Figs. 11, 23). Terbrack does not disclose attaching a second type of board in a new row to a first type in a preceding row. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this arrangement because the same resulting floor would be produced.

Claims 14 and 16: the floor is in parallel rows (Fig. 1).

Claim 15: the short side connectors are different from the long sides in that they are different lengths.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terbrack in view of Wasleff (U.S. Patent No. 1,787,027) and Shah (U.S. Publication 2003/0221387).

Claim 18: Terbrack discloses rectangular floorboards with long sides (Figs. 12 and 13) that lock together with both horizontal and vertical inward angling. Terbrack does not disclose the floorboard with a surface layer of laminate. Shah discloses a floor panel with a surface layer laminate (8). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a laminate on the board in Terbrack because it is well known in the art to

place laminates on floorboards to improve the aesthetic features of the board. Further, Terbrack does not disclose arranging the panel in a herringbone pattern, though Terbrack does disclose joining and disconnecting is achievable by an angular motion (see connections 41 and 40'). Wasleff discloses a floor system arranged in a herringbone pattern (Fig. 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to arrange the panel in Terbrack in a herringbone pattern because it is well known in the art to create a floor with a herringbone pattern and the mirror image panels of Terbrack (Figures 11 and 23) permit one to form a herringbone pattern.

Allowable Subject Matter

3. **Claims 1, 3-12 and 17** are allowed.

Response to Arguments

4. Applicant's arguments filed 29 August 2007 have been fully considered but they are not persuasive.

35 USC §112 rejection (Remarks page 6)

Applicant's amendment to Claims 13 and 17 overcome the rejection and it is withdrawn.

35 USC §103 rejection (Remarks page 6)

The Examiner respectfully disagrees with Applicant's statement that the prior art of record (Terbrack, cited above) does not show a short side connector designed to allow locking together by an essentially vertical motion. The Examiner wishes to note the circled section from attached Fig. 13 in Applicant's remarks. While the circled portion would require some non-vertical movement to interlock the panels, the panels are indeed locked by an essentially vertical motion. Figure 13 as shown would note that the upper panel would have to be lowered essentially vertically until it contacted the circled portion, then as the panel is further lowered, it would have to be moved in a non-vertical direction, however, the direction of the entire motion is essentially vertical.

35 USC §103 rejection (Remarks page 7

The Examiner respectfully disagrees with the Applicant's traversal of the combination of Terbrack, Wasleff and Shah (cited above). The Terbrack reference notes that the panel is

preferably from plastics material (Col. 1, lines 23, 24), but it is not inclusive. The panel is also used for bowling (Col. 1, lines 6-8) and it is well known in the art that bowling lanes are wood. Further, the limitation "decorative surface" is very broad and the any surface with any finish constitutes a decorative surface.

In addition, the Examiner respectfully disagrees that the panels in Terbrack can not be made in a herringbone pattern. In reference to Applicant's figure on page 7 of the Remarks, the Applicant attempts to make a herringbone pattern from a single species. However, if one used the species in Figure 11 of Terbrack in combination with the species of Figure 23, a herringbone pattern can be created.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

07 Nov 07

WVG

Primary Examiner Art Unit 3683 11/7/07